

REMARKS

Claims 64-66, 69-71, 80, 81, 86 and 87 are presently pending in the application. No claims have been amended. Favorable reconsideration of the application in view of the following remarks is respectfully requested.

Claims 64-71 (sic) have been rejected under 35 USC §103(a) as being unpatentable over Eddy et al (US 5,729,813). Eddy is cited as teaching a fuser member comprising a base, and a fusing surface layer comprising a fluoroelastomer and filler particles with a modulus greater than the modulus of the fluoroelastomer. Eddy limits the size of the filler particles to between 0.5 and 15 microns, preferably from 1 to 8 micron (col 7, lines 58-61) and most preferably 1 micron (col 7, lines 65-67). The Examiner states that it would have been an obvious matter of design choice to a person of ordinary skill in the art to have used a mean particle diameter of at least about 50 microns as recited in claims 64-66 or a mean particle diameter of greater than 55 microns as recited in claim 70 because Applicant has not disclosed that a mean particle diameter of greater than about 50 microns or greater than 55 microns provides an advantage, is used for a particular purpose or solves a stated problem. Applicants respectfully traverse this rejection.

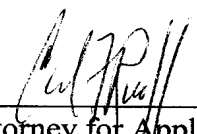
The Examiner states that it would be a matter of design choice to use a filler particle having a mean particle diameter of 50 microns or greater than 55 micron because Applicant has not shown that such a mean particle diameter is used for a particular purpose or solves a stated problem. Applicants again direct the Examiner to Table 2 wherein it is shown in Examples 5 and 6 that superior gloss and contamination numbers result when compared with Examples 1 and 2. Examples 5 and 6 have filler particles with 50 micron mean diameter while Examples 1 and 2 have mean particle diameters of 12 or 20. This unexpected result is not shown, taught or mentioned in Eddy. In fact, Eddy teaches away from the claims of the present invention as Eddy limits the size of the filler particles to between 0.5 and 15 microns, preferably from 1 to 8 micron (col 7, lines 58-61) and most preferably 1 micron (col 7, lines 65-67). The Examiner has stated that this argument is not persuasive because Applicants originally claimed subject matter included a size limitation of the filler particles of at least 8 microns. The Examiner then states that because Applicants have amended the claims only to overcome Eddy and not because other particle sizes are not suitable for

adequate performance that it is within the skill level in the art to have used any suitable particle size depending upon the desired conductivity needed for the roll. This rejection by the Examiner is improper. The Examiner has not provided an explanation as to why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification. The fact that Applicants originally claimed a lower range is not a proper explanation, rather, it is nothing more than hindsight reconstruction. Applicant has shown in his specification that filler particles having a size of 50 microns perform better than those of 12 microns. This performance improvement relates to improved gloss and lower contamination, not conductivity. Eddy teaches away from using filler particles of such size. The Examiner has ignored the teaching of Eddy in fashioning his rejection. There is no motivation or teaching shown by the Examiner that would allow one skilled in the art to use 50 micron or greater filler particles. Therefore this rejection should be withdrawn.

Claims 80-81 have been rejected under 35 USC § 103(a) as being unpatentable over Eddy et al., in view of Donnelley et al (US 3,669,707). Donnelley is cited to show the teaching of plastic filler particles. However, Donnelley does not cure the deficiencies of the 35 USC § 103(a) rejection above and, therefore, this rejection should also be withdrawn.

It is believed that the foregoing is a complete response to the Office Action and that the claims are in condition for allowance. Favorable reconsideration and early passage to issue is therefore earnestly solicited.

Respectfully submitted,



Attorney for Applicant(s)
Registration No. 34,241

Carl F. Ruoff/clb
Rochester, NY 14650
Telephone: 585-588-2718
Facsimile: 585-477-1148

If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at (585) 477-4656.